Appln No.: 10/828,394
Amendment Dated: November 30, 2005
Reply to Office Action of October 3, 2005

REMARKS/ARGUMENTS

This is in response to the Office Action mailed October 3, 2005 for the above-captioned application. Reconsideration and further examination are respectfully requested.

Claims 1 and 6 have been amended in view of the Examiner's objection.

Claims 1 and 6 were rejected under 35 USC § 112, first paragraph as lacking written description for therapeutic agents other than antisense oligonucleotides and siRNAs targeted to human clusterin. Applicants have amended claims 1 and 6 to refer to therapeutic oligonucleotide compositions. This amendment is made without admitting the correctness of the argument as to non-oligonucleotide agents and without prejudice to Applicants right to pursue broader claims in a separate application.

With respect to the class of therapeutic compounds that are therapeutic oligonucleotide inhibitors for species other than humans, Applicants submit that the intent of the written description provision is not to require extensive disclosure of things known in the art, or experimentation beyond that which is sufficient to allow the inventor to recognize the scope of his invention. In this case, sequences for clusterin in other species are known, as are antisense sequences targeted to clusterin in other species. (See, for example, Miyake et al., Cancer research 60: 170-176 (2000), of record, which discloses antisense targeted to murine TRPM-2 (clusterin)) Applicants plainly recognized, as of the filing date of the application, that the invention they had made, i.e., a method for treating cancer-associated angiogenesis, was not limited to humans. (See Page 4, lines 5, Page 6, lines 20-22). Thus, Applicants submit that application of a written description rejection in this instance is inappropriate.

The Examiner also rejected claims 1-3 and 6-8 under 35 USC § 112, first paragraph, as lacking enablement for *in vivo* treatment. A copy of a declaration submitted in a related case (09/967,726) showing *in vivo* testing in humans using intravenous administration is attached. Although the study was intended to look at toxicity, the antisense arrived at and was effective to bring about reduction in clusterin expression and clinical improvements in prostate and ovarian cancer patients. Nothing in the Examiner's arguments refutes the position that this type of effectiveness would not also be found for angiogenesis, as asserted this application, given the observations in the application which link reductions in angiogenesis to reductions in clusterin expression.

Applicants respectfully point out that

a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond to those used in

> describing and defining the subject matter sought to be patents *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112, *unless* there is a reason to doubt the objective truth of the statements contained therein, which must be relied upon for an enabling disclosure.

In re Marzocchi, 169 USPQ 367 (CCPA 1971). In this case, the Examiner has cited only references that speak in generalities and has not addressed the specific merits of the statements in the application. Furthermore, the declaration evidence that routine techniques as disclosed in the application do work to introduce antisense and reduce clusterin expression in *vivo* refutes any validity these arguments might have had. Thus, Applicants submit that the rejection for lack of enablement should be withdrawn.

Claims 1, 2, 6 and 7 stand rejected as anticipated by Monia et al. US 6,383,808. The Examiner states that Monia et al disclose all limitations of and anticipate claims 1, 2, 6 and 7. However, nowhere in the Official Action does the examiner identify where in Monia there is a disclosure of reducing angiogenesis. Every claim in the application, however, recites this as the purpose of the claimed method, and the Examiner may not ignore this as a claim limitation. .

> The Court of Appeals for the Federal Circuit has recently observed that
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> In general, a preamble limits the [claimed] invention if it recites essential structure or steps, or if it is 'necessary to give life, meaning, and vitality' to the claim." *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1784 (Fed. Cir. 2002) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)). "[A] claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995).

Eaton Corp. v. Rockwell International Corp., 66 USPQ2d 1271 (Fed. Cir. 2003). In the present case, the preamble cannot be deemed superfluous, since it says what is being accomplished by the method, namely a treatment of an angiogenesis-related cancer or reducing angiogenesis, and the claim without these words is meaningless. Indeed, the notion that preamble language is generally meaningless in method claims would render second use method claims impossible.

The importance of the preamble in method claims of this type is reflected in *Jansen v. Rexall Sundown, Inc*, 68 USPQ 2d 1154 (Fed. Cir. 2003). In that case, the claims at issue were

directed to "a method of treating or preventing macrocytic-megaloblastic anemia" by administration of a composition of defined components "to a human in need thereof." The accused product was a dietary supplement having a composition as defined in the claims. It was labeled for uses that did not include treating or preventing macrocytic-megaloblastic anemia. The Federal Circuit found that the claims were limited to the use, as stated in the preamble. Similarly, in *Rapoport v. Dement*, 59 USPQ2d 1215 (Fed. Cir. 2001) a claims directed to "a method for treatment of sleep apneas" was interpreted as being just that, and not a method for treating symptoms associated with sleep apneas, which was found in the art.

In *Jansen* the Federal Circuit observed that

> in both *Rapoport* and this case, the claim preamble sets forth the objective of the method, and the body of the claim directs that the method be performed on someone 'in need.' In both cases, the claims' recitation of a patient or a human 'in need' gives life and meaning to the preambles' statement of purpose. The preamble is therefore not merely a statement of effect that may or may not be desired or appreciated. Rather, it is a statement of the intentional purpose for which the method is performed.

Jansen at 1158. In this case, the claims are directed to "a method for treating angiogenesis-related cancer" or reducing angiogenesis in cancer cells. Treatment is given to "an individual" or to "cells" and is "effective to reduce the effective amount of clusterin in the" individual or cells. This recitation is equivalent to the "in need" statements of *Jansen* and *Rapoport*. The rejection for anticipation should therefore be withdrawn.

Claims 1-3 and 6-8 were rejected under 35 USC § 102(b) as anticipated by Gleave et al. (WO 00/49937), and under 35 USC § 102(e) as anticipated by Gleave et al 6,900,187 or Gleave et al (US 2003/0158130). Like Monia, none of these references disclose anything about angiogenesis or angiogenesis-related cancers. Thus, for the same reasons as Monia, they are not anticipatory.

Claims 1-3 are rejected for obviousness-type double patenting over claim 3 of US Patent No. 6,900,187. Applicants will file a terminal disclaimer upon receiving an indication that this application is otherwise in form for allowance, assuming that claims 1-3 remain in this application at that time.

Claims 1-3 are provisionally rejected for obviousness-type double patenting over claims 36-39 and 42 copending application Serial No. 09/967,726. Should it be appropriate upon receipt of an indication that the application is otherwise in form for allowance, a terminal disclaimer will be filed.

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Claims 1, 2, 6 and 7 are provisionally rejected for obviousness-type double patenting over claims 20-22 and 29 of copending application 10/646,436. Applicants submit that this rejection is inappropriate with respect to claims 6 and 7 since these claims require reduction of angiogenesis and there is no mention of angiogenesis in the specification or claims of the '436 application. Thus, the same invention is not claimed, and the rejection should be withdrawn.

For these reasons, subject to the filing of any needed terminal disclaimers, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully submitted,

Marina T. Larson, PhD
Attorney/Agent for Applicant(s)
Reg. No. 32038

(970) 468 6600

Enclosure:

copy of declaration from 09/967,726